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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,078	12/03/2003	Dasa Lipovsek	COTH-P04-507	7953

7590

07/01/2005

Patent Group
Ropes & Gray LLP
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Boston, MA 02110

EXAMINER

AUDET, MAURY A

ART UNIT

PAPER NUMBER

1654

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,078

Applicant(s)

LIPOVSEK ET AL.

Examiner

Maury Audet

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 26-31, 33, and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-25, 32, 34-41 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/04, 08/04, 03/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, claims 1-25, and 32, as drawn to the elected invention SEQ ID NO: 81, in the reply filed on 03/11/2005 is acknowledged. The traversal is on the ground(s) that "a sequence search is inappropriate where the claims are not drawn to a particular sequence" and that such a restriction would not be applied to "any other invention that is described by the words of the claims". This is not found persuasive because the claims are drawn to compounds, namely a myriad of structurally and functionally distinct peptides, which must be searched by structure rather than words. The structural search of any one peptide (i.e. SEQ ID NO: 81) is not coextensive; there being no recognizable core structure that runs through the myriad of peptides claimed that may be coextensively searched (see i.e. SEQ ID NO: 81, a 94 residue peptide versus i.e. SEQ ID NO: 32, a 10 residue peptide with no common core). Thus, the requirement to restrict the claimed subject matter to a searchable invention is proper.

The requirement is still deemed proper and is therefore made FINAL. The Examiner is willing to rejoin claims 34-37 (the methods for obtaining peptides) and claims 38-41 and 43, as drawn to the elected invention. Claims 1-25, 32, 34-41 and 43 have only been searched and examined as being drawn to SEQ ID NO: 81. Claims 26-31, 33, and 42 are withdrawn from consideration.

Claim Objections

Claims 1-25, 32, 34-41 and 43 are objected to because of the following informalities: the claims have not been amended to be drawn to the elected subject matter, namely a peptide comprising SEQ ID NO: 81. Appropriate correction is required.

Allowable Subject Matter

Claims 1-25, 32, 34-41 and 43, as drawn to elected invention SEQ ID NO: 81, are not reasonably taught or subject by the prior art of record. The claims would be in condition for allowance, if amended in accordance with the below.

In light of the allowable subject matter drawn to SEQ ID NO: 81, and in line with *In re Ochiai*, the Examiner was willing to rejoin claims 34-37 (the methods for obtaining peptides) and claims 38-41 and 43 (peptide compounds which bind tumor necrosis factor α). In response to this action, Applicant is asked to:

1. Amend all the elected and rejoined claims to be drawn to the elected invention (specifically, "comprising SEQ ID NO: 81"); and
2. Cancel the withdrawn claims not rejoined.

Conclusion

Claims 1-25, and 32; as well as rejoined claims 34-41 and 43 are in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

Art Unit: 1654

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA, 05/25/2005

A handwritten signature in cursive script that reads "Bruce Campell".

**BRUCE R. CAMPPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600**